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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,821	07/31/2001	Lorin Bruce Rowe	12177/50701	1755

23838 7590 08/05/2005

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EXAMINER

POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,821

Applicant(s)

ROWE, LORIN BRUCE

Examiner

Melvin H. Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached office action.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/18/05 have been fully considered but they are not persuasive. An analysis of the arguments is provided below.
2. In light of the amendment, the objection to claim 40 is withdrawn.
3. The applicant alleges that Brendzel does not expressly disclose retrieving a personal user list responsive to a user call (P. 14, lines 14-17). The examiner pointed to the off-hook mode in order to show the usage of this signal causes the information to be sent to the client (col. 6, lines 15-30), said information ultimately comprising some form of selectable hierarchical list (col. 5, lines 5-20), wherein selection of the hierarchical feature results in some transaction (col. 6, line 30 – col. 7, line 35), i.e. providing information about a selected item (col. 6, line 52 – col. 7, line 10, in view of col. 5, lines 20-60). While the selectable list may be any type, and while the term “personal user list” may also be considered a generic type, Brendzel teaches that the list may be a collection of names and related telephone numbers (col. 3, lines 30-50).
4. The applicant alleges that Brendzel does not expressly disclose transmitting converted/non-converted information (P. 14, lines 29-32), on the grounds that Brendzel does not expressly disclose converting part of the information into text.
5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Even if Brendzel did not disclose this feature, the addition of Srinivasan, which applicant did not address, discloses conversion

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processes followed by transmission of said components (Fig. 1) and thus the combination of teachings would still read upon the claims as drawn.

6. That said, the method of Brendzel needs to be further addressed. As shown, (Fig. 1, #20 and 31), the client phone has both a voice and data channel (col. 3, lines 52-60), in which some information is transmitted via voice and other data is transmitted via text data (col. 6, lines 1-5), which the instant application defines as non-converted data and converted data, respectively. Further, there may be a selection to transmit and receive non-converted audio data only (Fig. 3, #313). The examiner has conceded that Srinivasan is needed to teach voice-text conversion, but this is an intermediate step: Brendzel already teaches the text and voice data, and its transmission thereof. It simply does not expressly disclose the development of such data, and Srinivasan teaches a method to develop this step. Since Brendzel teaches the separation of data into two sections – text and non-text – so as to transmit over two separate channels, the functional equivalency of this claim part is fulfilled.

7. For the reasons above, the rejection is maintained and is therefore made final.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 32, 48, 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Brendzel (5,912,952).

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10. For claims 32, 48, and 55, Brendzel teaches a method (abstract) for providing an interactive, intelligent end user's service (col. 1, line 1 – col. 3, line 5), the method comprising:
- a. Responsive to a user call (Fig. 3, #302), retrieving a personal user list (col. 5, lines 5-20);
 - b. Transmitting information from the personal user list via the data control portion of a communications channel to a user device (Fig. 2);
 - c. Receiving a user response via the data control portion of the communications channel (Fig. 3, #306);
 - d. Retrieving additional information from the personal user list, the additional information corresponding to the received user response (Fig. 3, #309); and
 - e. Forwarding the additional information to a client device for processing (Fig. 3, #310).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-10, 15, 16, 19-21, 24, 25, 28, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brendzel (5,912,952) in view of Srinivassan (5,724,412).
13. For claim 1, Brendzel teaches a method (abstract) for providing (col. 1, line 1 – col. 3, line 5) interactive (col. 5, lines 5-17) text messages (Fig. 2) to a user's device (Fig. 1, #30) during a voice call (col. 3, lines 15-20), the method comprising:

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- a. Receiving information from a client (Fig. 1, #17; Fig. 3, #303);
 - b. Having at least a portion of the received information be in a text format (col. 3, lines 15-20);
 - c. Transmitting to the user's device non-text (voice) information on a voice portion of a communications channel (col. 3, lines 40-52); and
 - d. Transmitting to the user's device the text information on a data control portion of the communications channel (col. 3, lines 40-52).
14. Brendzel does not expressly disclose that the information is converted into text. Brendzel does disclose that, based on the type of screen, the same data may be shown in multiple ways (col. 6, lines 20-40). Srinivassan teaches a method (abstract) of providing textual data during voice calls (col. 1, line 1 – col. 3, line 17) in which a voice-to-text converter (Fig. 1, #34) provides such conversion (col. 5, lines 20-50). At the time the invention was made, one of ordinary skill in the art would have used a Srinivassan voice converter in the Brendzel system to assist in making sure the information is in a proper format using less database space (col. 2, lines 30-35).
15. For claim 2, Brendzel teaches that responsive to the transmitted converted information, receiving a user response on the data control portion of the communications channel (Fig. 3, #306 and 307).
16. For claim 3, Brendzel teaches forwarding the received user response to the client (Fig. 3, #309).
17. For claim 4, Brendzel teaches obtaining the user response from the data control portion of the communication channel (col. 5, line 10; col. 6, lines 40-48), but does not expressly disclose

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converting the user response into an audio message. Srinivassan teaches a text-to-voice converter (Fig. 1, #38) for conversion to the proper format (col. 4, lines 20-27). At the time the invention was made, one of ordinary skill in the art would have used a Srinivassan voice converter in the Brendzel system to assist in making sure the information is in a proper format using less database space (col. 2, lines 30-35).

18. For claim 5, Brendzel teaches forwarding the audio message to the client (col. 7, lines 13-28).

19. For claim 6, Brendzel teaches receiving the non-converted information via voice portion of the communications channel, and receiving the converted information via the data control portion of the communications channel at the user's device (col. 2, lines 50-51; col. 4, lines 9-11).

20. For claim 7, Brendzel teaches presenting the non-converted information as audio information on the user's device (Fig. 3, #313).

21. For claim 8, Brendzel does not expressly disclose displaying the converted data as text information on the user's device after a text alert is presented. Srinivassan teaches this limitation (col. 6, lines 50-60). At the time the invention was made, one of ordinary skill in the art would have used a Srinivassan voice converter in the Brendzel system to assist in making sure the information is in a proper format using less database space (col. 2, lines 30-35).

22. For claim 9, Brendzel teaches determining whether the received information contains information suitable for conversion into the text format (col. 4, lines 33-40).

23. For claim 10, Brendzel teaches separating the information that is suitable for text conversion from information that is not suitable for text conversion (Fig. 1, #16).

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24. Claim 15, 20, 24, 28 are drawn to the limitations in claims 1 and 10. Therefore, since claims 1 and 10 are rejected, claim 15 is also rejected for the same rationale.

25. Claim 16, 21, 25, 29 are drawn to the limitations in claim 2. Therefore, since claim 2 is rejected, claim 16 is also rejected for the reasons above.

26. For claim 19, Brendzel teaches that forwarding the received user response to the client for processing (col. 7, lines 10-30).

27. Claims 11-14, 17, 18, 22, 23, 26, 27, 30, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brendzel and Srinivassan as applied to claims 1, 10, 15, 16, 20, 21, 24, 28 above, and further in view of Dodrill et al. (6,738,803).

28. For claim 11, Brendzel does not expressly disclose converting the information that is suitable for text conversion into a text format for display on the user's device, and appending to the non-converted information a text alert, wherein the text alert is transmitted on the voice portion of the communication channel. Srinivassan discloses the text conversion and alert (see claim 8 discussion), but does not expressly disclose the text alert is transmitted on the voice portion of the communication channel. Dodrill teaches a method (abstract) of providing text-voice communications combinations (col. 1, line 1 – col. 6, line 15) that provides audio notifications for messages and the like (col. 11, lines 22-31). At the time the invention was made, one of ordinary skill in the art would have added a Dodrill notification method to Brendzel in order to provide advanced phone services (col. 5, line 65 – col. 6, line 5).

29. For claim 12, Brendzel does not expressly disclose transmitting to the user's device the converted information on the data control portion of the communications channel after the text

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alert is transmitted. Srinivassan teaches this limitation (col. 8, line 66 – col. 9, line 12). At the time the invention was made, one of ordinary skill in the art would have used a Srinivassan voice converter in the Brendzel system to assist in making sure the information is in a proper format using less database space (col. 2, lines 30-35).

30. For claim 13, Brendzel teaches receiving a trigger identifying the information suitable for conversion (col. 4, lines 33-50).

31. For claim 14, Brendzel teaches that responsive to the user response, retrieving stored information from memory; and forwarding the retrieved information to the client (col. 4, lines 50-65).

32. Claims 17, 22, 26, 30 are drawn to the limitations in claim 11. Therefore, since claim 11 is rejected, claim 17 is also rejected for the same rationale.

33. For claim 18, Brendzel teaches that the presented text includes a plurality of choices for selection by a user and the user response indicates at least a selected one of the plurality of choices (col. 5, lines 5-20).

34. Claims 23, 27, 31 are drawn to the limitations in claim 19. Therefore, since claim 19 is rejected, claim 23 is also rejected for the same rationale.

35. Claims 33-47, 49-54, and 56-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brendzel as applied to claims 32, 48, and 55 above, and further in view of D'Angelo (6,717,938).

36. For claims 33, 42, 49, and 53, Brendzel does not expressly disclose that the personal user list is a personal paging list, the personal paging list includes a plurality of names and

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corresponding paging numbers, nor does Brendzel expressly disclose that the personal user list is a personal directory list, the personal directory list includes a plurality a plurality of names and at least one of a plurality of corresponding telephone numbers, e-mail addresses and mailing addresses. D'Angelo teaches a method (abstract) of providing interactive services and combined voice/data networks (col. 1, line 1 – col. 4, line 6) in which a personal user list provided to the user (Fig. 6) comprises pager numbers, phone numbers, and the like (col. 16, lines 46-59). At the time the invention was made, one of ordinary skill in the art would have combined the inventions in order to allow greater control of Brendzel's communications options (col. 1, lines 25-35).

37. For claims 34 and 43, Brendzel does not expressly disclose that the information transmitted to the user device includes at least one of the plurality of names. D'Angelo teaches this limitation (Fig. 6, #604). At the time the invention was made, one of ordinary skill in the art would have combined the inventions in order to allow greater control of Brendzel's communications options (col. 1, lines 25-35).

38. For claims 35 and 44, Brendzel does not expressly disclose that the received user response includes a selection of the at least one of a plurality of names. D'Angelo teaches this limitation (col. 16, lines 50-52). At the time the invention was made, one of ordinary skill in the art would have combined the inventions in order to allow greater control of Brendzel's communications options (col. 1, lines 25-35).

39. For claims 36 and 45, Brendzel does not expressly disclose that retrieved additional information includes the paging number from the personal paging list, the paging number corresponding to the selected name, nor does Brendzel disclose that the retrieved additional

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information includes at least one of a plurality of corresponding telephone numbers, e-mail addresses and mailing addresses from the personal directory list. D'Angelo teaches this limitation (col. 16, lines 55-58). At the time the invention was made, one of ordinary skill in the art would have combined the inventions in order to allow greater control of Brendzel's communications options (col. 1, lines 25-35).

40. For claims 37 and 46, Brendzel does not expressly disclose that the paging number or telephone number is forwarded to the client device to complete a page and/or call. D'Angelo teaches this limitation (col. 16, lines 15-45). At the time the invention was made, one of ordinary skill in the art would have combined the inventions in order to allow greater control of Brendzel's communications options (col. 1, lines 25-35).

41. Claim 56 is drawn to the limitations in claims 33-37. Therefore, since claims 33-37 are rejected, claim 56 is also rejected for the same rationale.

42. Claim 60 is drawn to the limitations in claims 42-46. Therefore, since claims 42-46 are rejected, claim 60 is also rejected for the reasons above.

43. For claims 38, 50, and 57, Brendzel does not expressly disclose receiving a call back number, and forwarding the call back number to the client device to complete a page based on the paging number and the call back number. D'Angelo teaches this limitation (col. 12, lines 45-55). At the time the invention was made, one of ordinary skill in the art would have combined the inventions in order to allow greater control of Brendzel's communications options (col. 1, lines 25-35).

44. For claims 39, 47, 54, and 61, Brendzel does not expressly disclose that the call back number or other contact information is received on the data control portion of the communication

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channel. D'Angelo teaches this limitation (col. 5, lines 40-60). At the time the invention was made, one of ordinary skill in the art would have combined the inventions in order to allow greater control of Brendzel's communications options (col. 1, lines 25-35).

45. For claims 40, 51, and 58, Brendzel does not expressly disclose retrieving a plurality of call back numbers from the personal paging list, and forwarding the plurality of call back numbers via the data control portion of the communication channel to the user device for selection. D'Angelo teaches this limitation (col. 6, line 65 – col. 7, line 20). At the time the invention was made, one of ordinary skill in the art would have combined the inventions in order to allow greater control of Brendzel's communications options (col. 1, lines 25-35).

For claims 41, 52, and 59, Brendzel does not expressly disclose receiving a selected one of the plurality of call back numbers via the data control portion of the communication channel, and forwarding the selected call back number to complete the page based on the paging number and the call back number. D'Angelo teaches this limitation (col. 7, lines 20-55). At the time the invention was made, one of ordinary skill in the art would have combined the inventions in order to allow greater control of Brendzel's communications options (col. 1, lines 25-35).

Conclusion

46. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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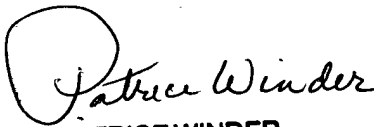
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
26 July 2005


PATRICE WINDER
PRIMARY EXAMINER